

REMARKS

I. Status of the Claims

Claims 1-167 are pending in this application. Claims 16-18, 22-29, 64-66, 70-77, 102-104, 108-115, 136-138, 142-149 and 151 are withdrawn from further consideration by the Examiner as being directed to non-elected inventions. Applicants again respectfully remind the Examiner of the duty to expand the search to non-elected species of invention should the elected species be found allowable. M.P.E.P. § 803.02.

In this Amendment, independent claims 1 and 130 were redrafted to explicitly recite that the composition in these two claims "provides durable non-permanent shaping of at least one keratinous fiber or durable retention of a non-permanent shape of at least one keratinous fiber." These amendments are fully supported by the specification and claims 1 and 130 as originally filed, and thus do not raise an issue of new matter.

Applicants thank the Examiner for indicating the allowable subject matter of claims 67-69, 78-79, 105-107 and 116-117. However, Applicants maintain that the remaining pending claims are also patentable for at least the reasons set forth below, and therefore wish to continue prosecution of all the pending claims in this application at this time.

II. Information Disclosure Statement

In order to gain full compliance with the provisions of 37 C.F.R. 1.97, 1.98 and M.P.E.P. § 609, Applicants provide clarification regarding the information disclosed as documents 12-15 and 18-19, as originally filed with the Information Disclosure Statement (IDS) on March 30, 2001.

First, Applicants have resubmitted documents 12-15. Applicants enclose an abstract in English to remedy any confusion. Applicants refer the Examiner to page 2 of the originally filed IDS for a discussion as to the relevance of these documents.

Second, Applicants enclose a Supplemental IDS with a complete listing of the abstracts disclosed in the literature searches of documents 18 and 19. Although the Examiner objected to documents 19 and 20, Applicants believe that the Examiner intended to object to documents **18 and 19**.

Therefore, Applicants respectfully submit that all the documents cited in the IDS and Supplemental IDS are in full compliance with the provisions of 37 C.F.R. 1.97, 1.98 and M.P.E.P. § 609. Accordingly, Applicants respectfully request consideration of all the cited documents by the Examiner, and an indication they were considered by making the appropriate notations on the forms attached to the two Information Disclosure Statements.

III. Written Description Rejection under 35 U.S.C. § 112 ¶ 1

The Examiner has rejected claims 1-15, 32-63, 80-101, 118-135 and 152-167 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement for the reasons disclosed at pages 3-5 of the present Office Action.

Applicants respectfully traverse this rejection for at least the reasons presented below.

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. M.P.E.P. § 2163, III. A. at 2100-176. The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. *Id.* The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of

the invention defined by the claims. *Id.* In rejecting a claim, the Examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. *Id.*

The Examiner has not met this burden in the present case. Applicants respectfully submit that there is **literal** support for the claim language and respectfully request the Examiner to consider the claims as filed and at least pages 16-17 of the Specification when reconsidering the written description rejection.

As an initial matter, Applicants point out that claims 1-15, 32-63, 80-101, 118-135 and 152-167 were rejected by the Examiner under § 112, first paragraph. These claims were all originally filed, and thus literal support for all the claims existed at the time of filing. Moreover, in the rejection itself, only the subject matter recited in claims 12, 60, 76, 98, and 132,¹ and claims 15, 63, 101, and 135 were referenced. No reasons for rejection were given for claims 1-11, 14, 32-59, 61, 62, 80-97, 99, 100, 118-131, 132, 133, and 152-165, which do not depend, either directly or indirectly, on any of these nine claims. Applicants therefore submit that the rejection of claims 1-11, 14, 14, 32-59, 61, 62, 80-97, 99, 100, 118-131, 132, 133, and 152-165 is in error since no reason for rejection was given by the Examiner.

Regarding the language of claims 12, 60, 76, 98, and 132 presumably drawn into question by the Examiner (“...further substituted with at least one group different from said at least one amino group”), Applicants submit that this language is particularly

¹ The rejection of these claims also failed to clearly state the claimed expression being rejected. See Office Action at page 3. (“[T]he written description is based upon the expression claimed in claims 12, 60, 76, 98, and 132.”) Based on language that follows in the rejection, it is believed that the Examiner is referring to the language “is further substituted with at least one group different from said at least one amino group.” Clarification is requested.

described, not only in the claims as originally filed, but also in the Specification on page 16, lines 9-12. ("As previously mentioned, the at least one C5 to C7 saccharide unit may be further substituted with at least one group different from the at least one amino group.") The Specification continues by providing non-limiting examples where the saccharide unit is substituted with (1) at least one amino group and further substituted with (2) at least one group different from the at least one amino group. Therefore, the Examiner has not provided sufficient evidence to rebut the presumption of written description adequacy.

With respect to the language recited in claims 15, 63, 101, and 135 drawn into question by the Examiner ("...polymers comprising at least one C5 monosaccharide substituted with at least one amino group, polymers comprising at least one C6 monosaccharide substituted with at least one amino group, polymers comprising at least one C7 monosaccharide substituted with at least one amino group, and glycoproteins comprising at least one C5 to C7 saccharide unit substituted with at least one amino group"), Applicants similarly submit that this language, in addition to being present in the claims as originally filed, is particularly described in the Specification on page 17, lines 3-8. ("[P]olymers comprising at least one C5 monosaccharide substituted with at least one amino group, polymers comprising at least one C6 monosaccharide substituted with at least one amino group, polymers comprising at least one C7 monosaccharide substituted with at least one amino group, and glycoproteins comprising at least one C5 to C7 saccharide unit substituted with at least one amino group.")

Therefore, in view of the language of the claims as originally filed, and the disclosure in the Specification, the Examiner has not provided sufficient evidence to

rebut the presumption of written description adequacy. Further, Applicants submit that a person skilled in the art would in fact recognize that as of the filing date Applicants were in possession of the claimed invention.

Accordingly, with respect to Claims 1-15, 32-63, 80-101, 118-135 and 152-167, Applicants submit that the application complies with the written description requirement of § 112, first paragraph, and request that this rejection be withdrawn.

IV. Indefiniteness Rejection under 35 U.S.C. § 112 ¶ 2

The Examiner has rejected claims 1-15, 32-63, 80-101, 118-135 and 152-167 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons disclosed at page 5 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

As above, the Examiner has rejected numerous claims, but the claim language in question is found in only four of the rejected claims. Specifically, the Examiner points to the language of claim 15 (with claims 63, 101, and 135 also containing this language). However, claims 1-14, 32-62, 80-100, 118-134 and 152-167 were rejected, yet these claims do not contain the referenced language. Accordingly, no basis to reject claims 1-14, 32-62, 80-100, 118-134 and 152-167 was set forth by the Examiner, and the rejection of these claims is therefore in error.

With respect to the language of claim 15 pointed to by the Examiner, Applicants respectfully remind the Examiner that the breadth of a claim is not to be equated with indefiniteness. M.P.E.P. § 2173.04 (citing *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)). As long as the scope of the subject matter embraced by the claims is clear, and if applicant has not otherwise indicated that they intend the invention to be of

a scope different from that defined in a claim, then the claim complies with 35 U.S.C. § 112, second paragraph. *Id.* In the present case, claims 15, 63, 101, and 135 each clearly recite what the at least one compound can be chosen from, and would, for example, encompass any polymer comprising the claimed monosaccharide units substituted with at least one amino group. Such compounds would be readily understood by one of ordinary skill in the art based on the concise language recited in the claim itself. Again, the breadth of a claim is not to be equated with indefiniteness.

Therefore, the Applicants submit that the language of the claims is clear and definite. Accordingly, with respect to claims 1-15, 32-63, 80-101, 118-135 and 152-167, Applicants request that the § 112 rejection be withdrawn.

V. Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1, 4, 9-11, 14-15, 19-21, 30, 32-43, 130-131, 134-135, 139-141, 150 and 152-163 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,141,964 to Noel ("Noel") for the reasons disclosed at page 6 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

In order to anticipate the claimed invention, a reference must "teach every aspect of the claimed invention either explicitly or impliedly." M.P.E.P. § 706.02. Further, the reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing and combining various disclosures." *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972). Importantly, the absence of a single element or limitation indicates the reference neither describes nor anticipates the claim. M.P.E.P. § 2131. Therefore, a rejection under

§ 102(b) is proper only when the claimed subject matter is identically described or disclosed in a single prior art reference. *In re Arkley*, 455 F.2d at 587.

Applicants respectfully submit that this rejection has been rendered moot by the amendments to Claims 1 and 130, which explicitly recite that compositions set forth in these claims provide durable non-permanent shaping of at least one keratinous fiber or durable retention of a non-permanent shape of at least one keratinous fiber. Noel, on the other hand, is directed to a skin moisturizer, and contains no disclosure with respect to providing durable non-permanent shaping of at least one keratinous fiber or durable retention of a non-permanent shape of at least one keratinous fiber.

Accordingly, with respect to claims 1, 4, 9-11, 14-15, 19-21, 30, 32-43, 130-131, 134-135, 139-141, 150 and 152-163, Applicants submit that the Examiner has failed to demonstrate that the rejected claims are anticipated by Noel, therefore and request that the § 102(b) rejection be withdrawn.

VI. Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-15, 30-43, 130-135, 139-141, 150 and 152-167 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U. S. Patents 5,141,964 to Noel (Noel); 4,240,450 to Grollier et al. (Grollier); and 5,866,142 to Riordan (Riordan) for the reasons disclosed at pages 6-8 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

In order to establish a *prima facie* case of obviousness, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” *See In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Specifically, the Examiner must meet three basic criteria. First, the prior art references, taken alone or in combination, must teach or suggest all of the claim limitations. Second, there must

be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. And finally, there must be a reasonable expectation of success. See M.P.E.P. §§ 2143.01-03.

It is not sufficient to merely "find every element of a claimed invention in the prior art [and for] an examiner to use the claimed invention itself as a blue print for piecing together elements Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations and quotations omitted). In the present case, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

The Examiner acknowledges that Noel "does not disclose the specific film forming agents claimed" and relies on the combination with Grollier and Riordan to remedy this deficiency. See Office Action at page 7. The Examiner has the burden to show that the prior art *suggests* the selection of the claimed film forming agent. However, the Examiner does not provide factual support showing that Grollier or Riordan *suggest or provide motivation* to select the claimed film forming agent. The Examiner does not explain why one skilled in the art would choose the claimed film forming agent over all other available cosmetic agents. Thus, the Examiner has provided no evidence to support the alleged motivation to combine Noel, Grollier and Riordan.

Accordingly, with respect to claims 1-15, 30-43, 130-135, 139-141, 150 and 152-167, Applicants submit that the Examiner has failed to demonstrate a *prima facie* case of obviousness and request that the § 103(a) rejection be withdrawn.

VII. Double Patenting Rejection

The Examiner has also rejected “claims drawn to compositions” on the basis of nonstatutory double patenting over “the claimed hexosamines of co-pending Application No. 09/820,858 and 09/820,648.” Office Action at page 8. Applicants respectfully traverse this rejection.

Applicants first point out that Application No. 09/820,648 is the current application, and the statement of rejection is in error for this reason. Further, with respect to Application No. 09/820,858, Applicants submit that the Examiner has failed to specifically point out which claims are being rejected in the present application by which claims in this co-pending application. Applicants are unable to respond to this rejection without knowing how the claims are being rejected. Accordingly, Applicants submit that statement of rejection over Application No. 09/820,858 is also in error.

VIII. Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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